

REMARKS

The Office Action mailed on April 17, 2009 rejected claims 87, and 90-104. With entry of this Amendment and Response claims 87, 94-97, and 101-104 will be pending and under consideration.

Applicant's Attorney thanks the Examiner for conducting an Examiner Interview on October 7, 2009. Applicant's Attorney and the Examiner discussed generally the art of record but no agreement was reached. Applicant respectfully submits that the amendments made herein are in response to the discussion between the Examiner and Applicant's Attorney during the interview. To the extent that any term or limitation is not sufficiently clear to the Examiner, the Examiner is invited to contact the Applicant's Attorney to discuss a more preferable term or limitation to be entered as an Examiner's Amendment.

Rejections Under 35 U.S.C. § 112, first paragraph

Claims 87, and 90-92 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicant respectfully disagrees with the Office Action's assertion that the amendments were not supported by the description; Applicant's statement was that "[s]upport for the amendments to claims 87 and 90-92 can be found throughout the specification, for example, paras. [0055] and [0056]." (emphasis added). *Office Action Response*, pg. 5. The cited paragraphs were by way of example only and Applicant did not indicate that the cited paragraphs were the *only* support for the amendments. Regardless, Applicant has amended the claims to utilize language from the specification in order to put the claims in better condition for allowance.

The Objections Of The Office Action

With respect to the Office Action's specific objection to the terms "portion of the video game" and "quantum of music content," Applicant submits that the specification reasonably conveyed to those skilled in the art that the applicant was in possession of the claimed invention as of the date of invention. *See* MPEP 2106, (V)(B)(1) ("[t]he claimed invention subject matter need not be described literally, i.e., using the same terms, in order for the disclosure to satisfy the

description requirement.”) Nevertheless, Applicant has amended the claims to more clearly describe the claimed subject matter and respectfully requests withdrawal of the objection.

Definitions And Amendments That Reflect The Claimed Subject Matter.

Although the specification supports the previous amendments, for clarity's sake, Applicant submits that the following terms are given definitions in, or are derived from, the specification and the claims are to be read in context thereof:

Music-based video game – “the term ‘music based’ video game refers to a game in which one or more of the dominant gameplay mechanics of the game are based on player interaction with the musical soundtrack.” *Specification*, ¶ [0016]. Examples of music-based games are provided such as Karaoke Revolution and BeatMania, both by Konami. Music-based games are contrasted with games such as Def Jam Vendetta, which is “a wrestling game featuring popular hip-hop artists as wrestlers and music from those artists on the soundtrack. The gameplay itself is simply wrestling, however, and thus not music based.” *Id.* Therefore, even if music is an aspect of the game, for the game to be a “music-based video game” as recited in the claims, the dominant gameplay mechanics must be based on player interaction with the musical soundtrack.

Musical content – a piece of music such as a song, a portion of a song, a composition, or an entire album that is used to create the music-based video game. Some examples in the specification: “...music content may represent a complete recorded music product, such as an entire album, or it may represent only a portion of a recorded music product, such as a single song, or a portion of a single song... [i]t may also represent a collection of songs from multiple recorded music products, such as a ‘greatest hits’ of a particular recording artist or by a group of artists...music content may not be a recording per se, but rather a composition that the game creator will have recorded.” *Specification*, ¶ [0018].

Before making the game, the musical content is received in one of various formats, e.g., on a DVD, CD, as an mp3, a wav file, as ProTools Session data, etc. *See, for example, Specification*, ¶ [0023]. The music-based game is created based on the musical content and then a recorded musical product including the musical content is sold along-side the music-based video game, e.g., on the same disc, as a file on the same web page, etc. *See, for example,*

Specification, ¶¶ [0055]-[0056]. In some embodiments, the game and the recorded music product are sold to the purchaser via a digital carrier, e.g., on a “single compact disc or DVD” (¶ [0056]) or as downloads from a website (¶ [0055]).

Digital carrier – a carrier that is used to convey digital information, for example, a compact disc or DVD or a downloadable file. *See, Specification*, ¶ [0055-0056]. Further examples are found in ¶ [0023], e.g., the musical content is described as being received “embodied on a *digital data carrier*, such as a hard drive, compact disc (CD), digital versatile disc (DVD), flash memory, or digital music tape (DAT). The musical content may be *received in a number of digital formats* such as mp3, aiff, wav, or wmv.” (emphasis added) *Specification*, ¶ [0023]. A *downloadable* digital carrier would be a downloadable file (as a physical DVD could not be downloaded). The specification teaches that the recorded music product can be embodied as a separate file or in an audio format different than that of the game. *See, generally, Specification*, ¶¶ [0055]-[0056]. One skilled in the art would appreciate that the recorded music product can therefore be played back independent of the game platform.

Purchased Carrier, Separate units – the music-based video game and the recorded music product are distinct units, e.g., the video game may be in one format such as a game format and the recorded music product is in an audio format. *See, generally, Specification*, ¶¶ [0055]-[0056]. The specification distinguishes between the recorded music product and the music-based video game throughout and therefore the two are not the same unit (as is the case with a downloadable level such as for Karaoke Revolution that contains music and gameplay that are not separable and the music cannot be played back independent of the game platform). The specification also repeatedly discusses purchasing the music-based video game and the recorded music together. *See, for example, Specification*, ¶ [0056] (“In some of these embodiments, the music content on which the video game is based may not be made separately available to consumers, that is, the only way for a consumer to purchase the music content is to buy the video game based on the music content.”).

Applicant has amended the claims to reflect language used in the specification, and submits that one reasonably skilled in the art would understand the subject matter of the amended claims in light of the specification, even if a compound term or a combination of terms is not found literally next to each other. If the Examiner objects to the use of any of the above terms or their definitions, the Examiner is invited to contact the Applicant's Attorney to discuss a more preferable term to be entered as an Examiner's Amendment or a Supplemental Response.

Rejections Under 35 U.S.C. § 103(a)

Claims 87, 93 and 95-104 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over E3 2003: Music Mixer Details (<http://xbox.ign.com/articles/401/401793p1.html>) ("Music Mixer") in view of XBOX Live to Launch on One-Year Anniversary Of Console Launch (<http://www.microsoft.com/presspass/press/2002/aug02/08-13xboxlivelaunch.pr.mspx>) ("XBL"). Because claims 93 and 98-100 are canceled, Applicant does not argue the patentability of these claims here, although Applicant reserves the right to reinstate these claims should the independent claim be found allowable, as well as the right to pursue them in a subsequent application. Based on the amendments made herein, Applicant respectfully submits that claims 87, 95-97, and 101-104 are patentable over the prior art.

The Office Action Does Not Support Its Finding Of Obviousness

The Office Has Not Made A Reasoned Analysis Of What Is Obvious

As specified by MPEP § 2141, "[o]bviousness is a question of law based on underlying factual inquiries." The factual inquiries enunciated by the Court are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the claimed invention and the prior art; and
- (C) Resolving the level of ordinary skill in the pertinent art.

Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459, 467 (1966). ... The question of obviousness must be resolved on the basis of these factual determinations. While each case is different and must be decided on its own facts, the *Graham* factors, including secondary considerations when present, are the controlling inquiries in any obviousness analysis.

(emphasis added). MPEP § 2141(II). The Office Action, however, undertakes none of this analysis. In fact, in the analysis section, “obvious” appears in the section quoting the 35 U.S.C. § 103 on page 3, and then only appears again at the end of the analysis of dependent claims 101-104, merely stating: “Thus it would have been obvious to an ordinary artisan to combine these prior arts in an attempt to create a more fulfilling experience for the player as an encouragement for the player to perform to their best,” on page 6. Instead, the analysis is supported merely by a conclusory statement that the claims – and only 101-104 – were obvious. The Supreme Court, and indeed the Patent Office, have explicitly stated that such conclusory statements are not enough.

Obviousness Cannot Be Established By Mere Conclusory Statements.

“A statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art at the time the claimed invention was made’ because the references relied upon teach that all aspects of the claimed invention were individually known in the art is *not sufficient* to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. (emphasis added) See MPEP § 2143.01(IV), citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). “Rejections on obviousness cannot be sustained by mere conclusory statements, instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR International Co. v. Teleflex Inc., et al.*, 127 S. Ct. 1727, 1740-41 (2007) quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). In the Office Action, however, the reasons for combining the art of record is supported only by conclusory statements.

The Prior Art Fails To Make The Claimed Limitations Obvious

Music Mixer And XBL, Alone Or Together, Fail To Teach A Music-Based Game As Recited By The Claims In Light Of The Specification.

The Office Action described Music Mixer and XBL together as teaching: “a karaoke game called Music Mixer that after its launch could offer downloadable songs via XBOX Live for a fee” and “portions of the game like new songs are stored on a server and offered to players through an online store. ...even if the songs were offered for free, the network is still a store since you have to pay to gain access to the network & the person is paying for the songs through the membership fee.” *Office Action*, pg. 3. The Office Action then states that the prior art is a music based video game with a portion of a video game based on a quantum of music content. Applicant respectfully disagrees.

The amended claims recite, in part, “a music-based video game based on musical elements of the musical content, wherein gameplay of the music-based video game comprises the game platform determining if the input actions performed by the player are done in synchronization with a playback of the musical content by the game platform.” (emphasis added). Neither Music Mixer, nor XBL, teach a music-based video game that determines if the player’s actions are performed in synchronization to the music. Respectfully, the Office Action mischaracterizes Music Mixer as a game. It is not a game; it is karaoke software that has no apparent gameplay element or determination as the accuracy of the player’s performance. According to the cited reference, it only includes “10 hours of visual media, two handfuls of classic karaoke songs, a near-complete music CD database, and everything you need to turn your Xbox into a machine worthy of the term ‘next-generation’.” Nothing in the Music Mixer reference discusses it being a music-based game as used in Applicant’s claims or specification. XBL also does not disclose a music-based video game. Therefore, since neither reference teaches a music-based video game, the combination of Music Mixer and XBL cannot teach the invention as claimed for at least this reason.

Applicant notes that the Final Fantasy reference (found at <http://psx.ign.com/articles/161/161674p1.html>) that is cited in prior Office Actions is also not a music-based game. Specifically, Final Fantasy is a Role-Playing Game and, although it contains an Opera Scene that is music-oriented, it is not music-based in the context of the specification (see music-based

definition above with respect to Def Jeam Vendetta as distinguished in the specification). For example, the Opera Scene requires players to select the correct music from a menu. The Office Action mailed on 02/21/2008 acknowledges this menu-driven approach, which is not indicative of gameplay in a music-based game. See *Office Action mailed 02/21/2008*, pg. 2 (“[o]nce on stage the player must choose from a list of lines the next correct line before time runs out or he or she will have to repeat the whole scene.”) No judgment is performed as to timing, pitch, etc. as is typical of music-based games. Therefore, Applicant presents that the Final Fantasy reference does not teach a music-based game (as the term is used herein), nor does it render the amended claims as obvious, either by itself or in combination with the other references.

Applicant recognizes that creating a music-based game based on musical content alone does not make the invention patentable. Karaoke Revolution, cited for other reasons, as well as other music-based games specified in the Applicant’s specification, involves the game platform determining if the input actions are in synchronization with the playback of the musical content. Applicant presents the arguments above merely to illustrate that Music Mixer and XBL (or Final Fantasy) by themselves do not -- and indeed cannot -- supply the claimed limitations and thus do not make claim 87 and its dependent claims obvious.

Karaoke Revolution (And Other Rhythm-Action Games) Do Not Teach A Downloadable Digital Carrier That Includes Both The Music-Based Video Game And A Recorded Music Product As Separate Units.

Although Karaoke Revolution is a music-based video game, Karaoke Revolution does not teach offering a downloadable digital carrier that includes the music-based video game and a recorded music product. In fact, the ability to download additional levels or songs is not discussed at all in Karaoke Revolution. Although XBL teaches downloading additional levels, and assuming *arguendo* that the combination teaches downloading new songs into Karaoke Revolution, the combination still fails to teach a downloadable carrier that includes both the music-based video game and a recorded music product as separate units as recited by the amended claims. None of the music-based games of record appear to teach the limitation of a downloadable digital carrier that includes both the music-based game and a recorded music product as separate units. Without such a teaching, the claims as amended cannot be obvious.

Music Mixer And XBL Do Not Teach A Downloadable Digital Carrier That Includes Both The Music-Based Video Game And A Recorded Music Product As Separate Units.

Although XBL discloses downloading content such as new levels to the Xbox, it does not disclose purchasing a downloadable digital carrier that contains both a music-based game and the associated recorded music product that the game is based on. The Office Action implies that Music Mixer provides this by downloading the track, performing ripping processes on the track to remove the vocals, and storing the vocal-less track on the Xbox. That, however, is not the same as, nor does it suggest as an obvious variation, providing both the music-based game and the recorded music product together in a downloadable digital carrier. If the additional ripping process were not undertaken, the user would only have the purchased recorded music product. Furthermore, nowhere in either XBL or Music Mixer is the limitation taught of creating a music-based game (i.e., a game in which one or more of the dominant gameplay mechanics of the game are based on player interaction with the musical soundtrack) from the musical content.

Music Mixer And XBL, Alone Or Together, Fail To Teach Playback Of A Recorded Music Product Or Musical Content Independent Of The Game Platform.

The Office Action also asserts that Music Mixer and XBL taught playback of the musical content independent of the game platform for the following reasons:

Music Mixer discloses the software's ability to broadcast locally and globally ripped music across the Internet (E3: Global Rave, par. 3). Furthermore, the Music Mixer is able to save a karaoke performance to the hard drive and play them as a custom soundtrack (E3: Your Own Karaoke Lounge, par. 2). Thus the prior art teaches the playback of any songs saved on the hard drive occurring outside or independent of the game platform that stored the songs. (emphasis added). (Office Action, pg. 4.)

Applicant notes – only for clarity's sake as the alleged functionality of Music Mixer relates to the amended claims –that every reference to “hard drive” in the Music Mixer reference refers to the hard drive of the Xbox. The Music Mixer reference in fact makes several references to music being transferred from a PC to the Xbox, but makes no mention of the music being in a format such that playback of the music, once it is on the Xbox, can be achieved independent of the game platform. Furthermore, the “global rave” taught by Music Mixer is accomplished by the game platform and cannot therefore be independent of the game platform. Therefore,

Applicant respectfully submits that Music Mixer does not teach playback of musical content, or a recorded music product, independent of the game platform.

The Art Of Record Fails to Teach Or Make Obvious The Claimed Invention

In light of the amendments made to the claims, and the arguments presented herein, the art of record, alone or in combination, fails to teach the claimed limitations, or make the claimed limitations obvious. None of the references, alone or together, teach or make obvious a downloadable digital carrier that includes both the music-based video game and a recorded music product as separate units. Without at least this teaching, Applicant respectfully submits that the claims overcome the teachings of the prior art and are in condition for allowance.

CONCLUSION

Applicant's discussion of particular positions of the Office Action or the Examiner does not constitute a concession with respect to any positions that are not expressly contested by the Applicant. Applicant's emphasis of particular reasons why the claims are patentable does not imply that there are not other sufficient reasons why the claims are patentable. Applicant's amendment of the claims does not constitute a concession that the claims are not allowable in their unamended form.

In view of the foregoing remarks and the inability of the prior art, alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. Applicant respectfully requests consideration and allowance of all of the pending claims. The Examiner is respectfully requested to telephone the undersigned at the number below to discuss any further issues in this matter.

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